

**REMARKS**

Claims 1-30 are pending in this application after this Amendment. Claims 1, 2, 16, 17, and 22 are independent. In light of the amendments and remarks made herein, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections.

In the outstanding Official Action, the Examiner objected to claim 2. The Examiner further rejected claims 1-4, 6-13, 15-18, and 22-23 under 35 U.S.C. § 103(a) as being unpatentable over *Henderson* (USP 5,897,648) in view of *Lazzouni et al.* (USP 5,652,412); rejected claim 5 under 35 U.S.C. § 103(a) as being unpatentable over *Henderson* in view of *Lazzouni et al.*, and further in view of *Moody et al.* (USP 5,890,177); and rejected claims 14 and 19-21 under 35 U.S.C. § 103(a) as being unpatentable over *Henderson* in view of *Lazzouni et al.*, and further in view of *Dymetman et al.* (U.S. Patent Application Publication No. 2002/0020750). Applicants respectfully traverse these rejections.

**Claim Objections**

With regard to the Examiner's objection to claim 2, by this Amendment, Applicants have amended claim 2 as suggested by the Examiner. Based upon this amendment, it is respectfully requested that the outstanding objection be withdrawn.

**Claim Rejections - 35 U.S.C. § 103 -  
*Henderson/Lazzouni et al.***

In support of the Examiner's rejection of claim 1, the Examiner asserts that *Henderson* teaches all of the claim elements except for a printing device that prints the document information on a surface having a position-coding pattern. The Examiner admits *Henderson* fails to teach this claim element. The Examiner relies on the teachings of *Lazzouni et al.* to cure the deficiencies of the teachings of *Henderson*, asserting *Lazzouni et al.* teaches a method for editing a document, citing to the entire patent. Specifically, the Examiner asserts *Lazzouni et al.* teaches as follows:

a printing device that prints the document information on a surface having a position-coding pattern (the electronic document editing system allows the user to print a document on a paper having a prerecorded pattern of pixels), for the purpose of allowing handwritten data to be entered into an electronic document without the use of a digitizer.

The Examiner concludes it would have been obvious to one of ordinary skill in the art to modify the method disclosed in *Henderson* to include a printing device that prints the document information on a surface having a position-coding pattern for the purpose of allowing handwritten data to be entered into an electronic document without the use of a digitizer. Applicants respectfully disagree with the Examiner's characterization of these references and further disagree that these references are properly combinable.

In order to sustain a rejection under 35 U.S.C. § 103(a), it is respectfully submitted that the Examiner must meet his burden to establish a *prima facie* case. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The disclosure of *Henderson* is directed to an apparatus and method for editing electronic documents. As discussed in the Field of the Invention, *Henderson* states that the present invention relates to the use of an x-y digitizer to edit an original or hard copy of a document that has been previously stored in electronic form. As indicated in the Summary of the Invention, the apparatus utilized for editing the documents includes means for positioning an original document on an x-y digitizer (col. 2, lines 45-46). As can be seen in Figs. 1-3, the x-y digitizer is integral in performing the editing method as set forth in the disclosure of *Henderson*. In discussing the flow diagram depicted in Fig. 1, *Henderson* notes that the digital document may be created first, followed by printing of the document to obtain a hard copy thereof.

The original document is then positioned in a fixed location on an x-y digitizer pad (col. 3, lines 53-55). Once the original document is positioned on the digitizer, its position must be correlated with the electronic version of the document (col. 3, lines 59-61). Editing is performed with a digitizer pen that, in conjunction with the digitizer surface, converts the handwritten edit into digital form (col. 4, lines 3-6). *Henderson* additionally notes that suitable digitizer pens may include writing instruments such as ink pens, graphite pencils, wax pencils and the like, as well as non-marking instruments, cursors, fingers, pointers, light emitting pens, ultrasonic emitting pens, and **any other device that can be used to indicate the x-y coordinate position of the pen in relation to the x-y digitizer** (col. 5, lines 25-33). The digitizer further is incorporated in each of the independent claims as set forth in the *Henderson* reference.

The disclosure of *Lazzouni et al.* is directed to a pen and paper information recording system. The information recording system as disclosed merely provides for a writing paper having a prerecorded invisible pattern of pixels associated with the writing surface for use with a pen including a detector for detecting the position of the tip on the writing surface by optically reading the pixels and obtaining the position information when the tip is in contact with the surface (Abstract). There is no discussion in

*Lazzouni et al.* that is directed to editing documents as asserted by the Examiner.

In support of the Examiner's rejection, the Examiner purports to essentially replace the digitizer of *Henderson* with the surface having a position-coding pattern as set forth in *Lazzouni et al.* It is respectfully submitted that this purported combination is wholly improper. First, it is respectfully submitted that one of ordinary skill in the art would not be motivated to modify a device which detects the position of the pen from an x-y digitizing tablet with an arrangement to read position codes imprinted on a surface. There is simply no motivation to make such a change as asserted by the Examiner.

Second, it is well known that if the proposed modification or combination of the prior art would change the principal operation of the prior art invention being modified, then the teachings of the reference are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 439 (CCPA 1959). As noted above, the apparatus of *Henderson* is directed to an x-y digitizer in a tablet form that determines the location of a pen by detecting its presence at a sensed location. To suggest modifying the invention where a pen device digitizes its movement by detecting and decoding a position-coding pattern would change the principal operation of the apparatus of *Henderson*. Further, in making such a combination, a substantial modification in the

functionality of the *Henderson* reference necessarily needs to be made and, ultimately, would render the apparatus of *Henderson* inoperative. One of ordinary skill in the art would not be motivated to make this modification. As such, the application of the teachings of the references as suggested by the Examiner is insufficient to render the claims *prima facie* obvious. Consequently, no *prima facie* case is made and the combination cannot fairly be made. It is respectfully requested that the outstanding rejection be withdrawn.

As the Examiner has relied on the combination of the teachings of these two references in support of his rejection of all the claims, it is respectfully submitted that, as these references are not properly combinable for the reasons set forth above in addition to the lack of motivation set forth above, all of the pending claims are patentable over the references are cited by the Examiner and, as such, it is respectfully requested that all outstanding rejections be withdrawn.

#### **Additional Comments**

On March 29, 2002, Applicants filed an Information Disclosure Statement. To date, Applicants have not received a signed copy of Form PTO-1449. Applicants respectfully request consideration of the documents contained in the Information Disclosure Statement.

Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinet (Reg. No. 52,327) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.


If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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